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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,183	01/13/2000	Daniel R. Tretter	10980251-1	8066

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EXAMINER
BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
2134	3

DATE MAILED: 08/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
Office Action Summary	09/483,183	TRETTER ET AL.
	Examiner	Art Unit
	Christopher J Brown	2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 May 2000</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *1/13/00* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6)☐ Other: .

U.S. Patent and Trademark Office
PTO-326 (Rev. 04-01)   Office Action Summary   Part of Paper No. 3

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 18 recites the limitation "the remote site" in line 3. There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-5, 7, 9, 12, 15, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Chan US 6,378,070 in view of Pouge Jr US 5,144,667.

2. As per claim 1, Chan discloses a method using a printer to distribute a document

stored on a server, the server being connected to a network, (col 2 lines 10-15). Chan

discloses using the printer to decrypt the document, (Col 7 lines 45-48). Chan discloses

using the printer to print the decrypted document, (Col 7 lines 50-51).

Chan does not disclose using the printer and at least one key to establish a printer identity

with the server.

Pouge Jr. discloses an authentication method that has a server (base) send an encrypted

token to a printer (remote unit), (Col 4 line 64). Pouge Jr. discloses that the printer

(remote unit) uses a decryption key to decrypt the token, and send the result back to the

remote unit (base), (Col 5 lines 24-30). If the token from the printer matches the token at

the remote unit, the printer is authenticated, and the identity is established.

It would be obvious to one of ordinary skill in the art to modify Chan's printing system

with Pouge Jr's authentication system, because it provides a high level of security,

(Pouge Jr. Col 1 line 43).

As per claim 3, Chan discloses that the printer identity is established by inserting a smart

card, (Col 6 lines 58- Col 7 line 4).

As per claim 4, Chan discloses the smart card is used to perform the decryption, (Col 7

lines 52-54).

As per claim 5, Chan discloses an embedded processor (CPU), wherein the processor is

used to perform decryption, (Col 4 lines 32-36).

As per claim 7, Chan discloses the printer is used to order the document, (Col 7 lines 13-

19).

As per claim 9, Chan does not disclose authentication.

Pouge Jr. discloses authentication as a security measure. It would be obvious to

authenticate the printer before documents were ordered.

As per claim 10, 23 Chan discloses using the printer to render (print) the decrypted

document, (Col 7 lines 50-51).

As per claims 12, and 18, Chan discloses a remote print server with stored documents, (Col 2 line 20). Chan discloses sending a network printer with the means to read a decryption key, (Col 7 line 37). Chan discloses means for receiving an encrypted document from the network, (Col 7 line 45). Chan discloses using a decryption key to decrypt the document and print it, (Col 7 line 47).

Chan does not disclose receiving an encrypted token, decrypting it, and sending the decrypted token back to the remote site.

Pouge Jr. discloses an authentication method that has a remote site (base) send an encrypted token to a printer (remote unit), (Col 4 line 64). Pouge Jr. discloses that the printer (remote unit) uses a decryption key to decrypt the token, and send the result back to the remote unit (base), (Col 5 lines 24-30). If the token from the printer matches the token at the remote unit, the printer is authenticated.

It would be obvious to one of ordinary skill in the art to modify Chan's printing system with Pouge Jr's authentication system, because it provides a high level of security, (Pouge Jr. Col 1 line 43).

As per claim 15, Chan discloses a smart card that passes a cryptographic key to the printer, is able to decrypt a document, and pass the document to the printer, (Col 7, lines 38, 52).

As per claim 16, Chan discloses a smart card send a key to the printer so that an embedded processor (CPU), in the printer may perform the decryption, (Col 4 lines 32-36, Col 7 line 35).

As per claim 19, Chan discloses a network printer with a smart card reader, a network

interface, and a processor, (Col 4 line 20). Chan discloses a memory for a program that

directs the smart card to release a key so that the printer can decrypt a document obtained

from the network, and print it, (Col 7 line 30).

As per claim 20, Chan discloses the printer has a keypad and display, where the

document may be obtained using the keypad, (Col 7 lines 15-20).

Claims 2, 11, 17, 21, and 22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Chan US 6,378,070 in view of Pouge Jr. US 5,144,667 and in view of

Furman US 5,483,653.

3. As per claim 2,and 22 Chan as modified above, discloses sending an encrypted

document to a printer. Chan does not disclose a message that indicates the number of

copies to be printed.

Furman discloses a message send with a document (job ticket) that indicates the number

of copies to be printed, where the printer prints the number of document copies indicated

in the message, (Col 6 lines 26-31, Col 7 lines 7-12, 32-35, Fig 3).

It would be obvious to modify Chan's encryption of documents with Furman's printer

instructions because it provides the printer with needed instruction.

As per claim 11, 17, and 21, Chan discloses a printer with a status display. Chan does not

disclose that the display shows the status of the copies printed.

Furman discloses that the user can determine the status of printing through the server,

(Col 4 lines 20-24).

It would be obvious to modify Chan's print system with Furman's status screen because

it provides lets the user know when his print jobs are complete.

Claims 6, 8, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Chan US 6,378,070 in view of Pouge Jr. US 5,144,667 and in view of Peairs US

5,717,940.

4. Chan as modified above shows the limitations of Claim 1.

As per claim 6, Chan does not disclose ordering a document before establishing printer

identity.

Peairs discloses ordering a document without regard for printing. The printer identity is

not established, (Col 2 lines 44-60).

As per claims 8, and 14, Chan does not disclose previewing at least one low quality

document before ordering.

Peairs discloses a server that stores low quality document previews, (Col 4 lines 25-27,

57-59).

It would be obvious for one skilled in the art to modify Chan's printing system, with de

Peairs preview system because seeing a preview allows a user to easily select the

document they are seeking.

As per claim 13, Chan does not disclose using a client to order the document.

Peairs discloses using a client (through a network) to order a document, (Col 4 line 62).

It would have been obvious to one skilled in the art to modify the print system of Chan

with the ordering system of Peairs to reduce the waiting time at the printer.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J Brown whose telephone number is 703-305-8023. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7239 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Christopher J. Brown

August 6, 2003

GREGORY MORSE
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